

REMARKS

This is in response to the Official Action currently outstanding with respect to the above-identified application, which Official Action the Examiner has designated as FINAL.

Claims 1-11 were present in this application as of the time of the issuance of the currently outstanding FINAL Official Action. By the foregoing Amendment, it is proposed that Claims 1, 10 and 11 be amended. Applicants propose the addition of no New Claims nor the cancellation of any claims. Accordingly, in the event that the Examiner grants entry of the foregoing Amendment, Claims 1-11 as hereinabove amended will constitute the claims under active prosecution in this application.

The claims of this application showing the changes proposed by this Amendment are shown above as required by the Rules.

More specifically, it is noted that in the currently outstanding Official Action, the Examiner has:

1. Acknowledged Applicants' claim for foreign priority under 35 USC 119(a)-(d), and indicated that the required certified copies of the priority document have been received by the United States Patent and Trademark Office.

2. Acknowledged Applicants' Information Disclosure Statement as filed with this application by again providing Applicants with a copy of the Form PTO-1449 that accompanied that Statement duly signed, dated and initialed by the Examiner to confirm his consideration of the art disclosed therein, however, Applicants Information Disclosure Statement of October 23, 2003 remains unacknowledged;
3. Failed to provide Applicants with any indication concerning the acceptability of the drawings filed as part of this application;
4. Rejected Claims 1 and 3-11 under 35 USC 102(b) as being anticipated by the Kay, et al reference (U.S. Patent 5,444,143); and
5. Rejected Claim 2 under 35 USC 103(a) as being unpatentable over the Kay, et al reference as applied to Claims 1 and 3-11 and further in view of the Bernstam reference (U.S. Patent 6,322,868).

Further comment in these Remarks regarding items 1-3 above is not considered to be necessary except to respectfully request an indication concerning the acceptability of the drawing of this application in response to this communication.

As previously stated in response to the previous Official Action in regard to this application, without prejudice to their right to further argue the substance should it become necessary or desirable to do so, Applicants presently rely upon the patentability of the independent claims as support for the patentability of the dependent claims of this application. Accordingly, since Applicants respectfully submit that Claims 1, 10 and 11 as hereinabove amended are patentable for the reasons set forth below, it is respectfully submitted that Claims 2-9 also are patentable. Further specific discussion concerning the Examiner's rejections of Claim 2 under 35 USC 103(a) and Claims 3-9 under 35 USC 102(b), therefore, is not considered to be required in these Remarks.

With respect to the Examiner's rejections under 35 USC 102(b), Applicants hereinabove propose that Claims 1, 10 and 11 be amended in a manner that more clearly states the subject matter that the Applicants regard as their invention. These proposed amendments are believed to place the claims of this application in condition for allowance, or at least in better form for Appeal, and not to introduce any issues that would require further consideration and/or search by the Examiner.

The basis for Applicants' assertion that the foregoing amendments would require no further consideration and/or search is that the proposed amendments merely make explicit that which was previously implicit in the claims of this application. In this respect Applicants note that the Examiner has refused to construe the term "compensation film" as used in the present claims in accordance with the explanation the function of that element found in the specification. The Examiner's stated reason for this is that to do so would effectively be to read limitations from the specification into the claims, rather than simply interpreting the claims in light of the specification.

Applicants respectfully disagree with the Examiner's conclusion on the latter point. It is so well known in the art as not to require citation that a compensation film modifies light rays passing through it (typically the polarization and/or travel direction thereof). Accordingly, Applicants respectfully submit that the subject matter of the above-proposed amendments was implicitly within the scope of the independent claims as previously presented (particularly when those claims were read in light of the specification as the Examiner has admitted that they must be), and explicitly within the scope of dependent Claim 2. Consequently, the subject matter of the above-proposed amendments may be deemed to have been before and considered by the Examiner during his previous examination of this application.

In view of the foregoing, Applicants respectfully submit that the entry of the above-proposed amendments is appropriate at this stage of the present prosecution and that in view of the following Remarks it is clear that the above-proposed amendments place this application in condition for allowance, or at the very least in better form for Appeal as required by 37 CFR 1.116.

As was pointed out in response to the previous Official Action, in order for a rejection of a pending claim based upon anticipation under 35 USC 102(b) to be valid, the Examiner's bases for the rejection must comply with the following:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) "The identical invention must be shown in as complete detail as contained in the ... claim." *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) "The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required." *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990) See, MPEP 2131

In the present Final Official Action, the Examiner disagrees with Applicants assertion that his anticipation rejections under 35 USC 102(b) do not satisfy these tests. In particular, the Examiner argues that the Kay reference discloses a transparent optical compensation film (which he characterizes as element 34) integrated with other elements of the Kay system *and that the features of the presently claimed compensation film relied upon by the Applicant cannot be "read into the claims" from the specification.*

Applicants respectfully disagree with the Examiner's characterization of element 34 of the Kay reference, and respectfully submit that even if his latter point might be deemed to be correct, the subject matter he alleges to be missing from the previously submitted claims was clearly within the scope of his original consideration and search concerning this application and will be expressly present in the claims upon his entry of the above-proposed amendment thereby overcoming the prior art and placing this application in condition for allowance.

Turning now to the substance of the outstanding claim rejections, the Examiner suggests that the Kay, et al reference discloses a transparent optical element designated by reference numeral 34 that may be integrated with a grating beam splitter designated by the reference numeral 44. Applicants do not disagree that in the Kay reference elements 34 and 44 may be integrated with each other. Applicants, however, strenuously disagree with the proposition that the element 34 of the Kay reference is an optical compensation film as contemplated by the present specification and claims.

The function of the optical compensation film of the present invention is clearly described at page 5, line 32 to page 6, line 1, and at page 9, lines 2-8, among other locations in the present specification. The grating beam splitter and the transparent optical component of the Kay, et al reference simply do not function in the same manner as the transparent optical compensation film of the present invention as Applicants herein propose that it be specifically claimed in view of the Examiner's comments.

More specifically, the Examiner asserts that the Kay, et al reference discloses an integrated unit that includes elements that meet all of the limitations of the claims of this application. In so doing, the Examiner suggests that the Kay et al reference shows a transparent optical compensation film designated by the reference numeral 34 integrated in the same integrated unit in which the diffraction element and the casing are integrated. In support of this assertion, the Examiner calls attention to the Kay, et al. reference at Column 4, line 31 to Column 5, line 35 and Fig. 1, reference numerals 30, 32, 34 and 42. A review of the Kay, et al. reference indicates, however, that the numeral 30 refers to the entire "laser-detector grating unit (LDGU)", the numeral 32 refers to a housing, the numeral 34 refers to a transparent substrate, and the numeral 42 refers to a grating beam splitter. **There is absolutely no teaching, disclosure or suggestion in the Kay, et al. reference that the transparent substrate 34 is contemplated to be an optical compensation film or to in any way evidence a compensation function.**

In this regard, Applicants again call attention to the fact that Kay, et al. define their "transparent substrate" as "any transparent material, including glass, plastic or film which may be used to support a grating beam splitter formed therein or thereon (see Column 5, lines 31-34). The Kay, et al. reference, however, does not contemplate that the transparent substrate 34 will function as, a compensation film useful in overcoming the birefringence effects of a target optical disk.

Indeed, while Kay, et al. realize that so-called circularization of the laser beam generally is known to be beneficial (see, column 2, lines 9-14), they nevertheless never indicate that their transparent substrate 34 is to demonstrate compensation effects. Indeed, the only statement concerning the optical effects of the Kay, et al. transparent substrate of which Applicants are currently aware states: "(a) zeroth order diffraction component of the radiation beam passes **undeflected** through the transparent substrate 34 and the grating splitter 42 formed thereon and is collimated by the collimating lens 44". (See, Kay, et al., Column 4, lines 54-58).

Accordingly, it must be re-emphasized that as far as Kay, et al. are concerned, such polarization compensation effects as are to be accomplished in their system are to be achieved by **a separate lens supported by mounting means separate from the remainder of the apparatus** (See, Kay, et al., Column 3, lines 42-45; Column 4, line 64 to Column 5, line 2; Column 10, line 59 to Column 11, line 16; and Claim 11; among other locations within the Kay, et al. reference). This lens is stated to impart desirable circularity to the laser beam and thereby to "improve throughput efficiency". (See, Kay, et al., Column 3, lines 41-44) Also, as has already been alluded to, Applicants have not been able to locate any teaching, disclosure or suggestion within the Kay, et al. reference to the effect that a compensation film should be integrated with any other element or elements of the apparatus.

The Examiner's reliance upon parts of the Kay, et al. specification such as Column 6, lines 18-24 concerning the fact that a reflector may be (i) supported by a casing cap, (ii) incorporated into the substrate 34 or (iii) otherwise mounted elsewhere within the casing also are respectfully submitted to be inapposite to the disposition of a transparent optical compensation film within the apparatus disclosed and claimed in this application. Further, these sections of the Kay, et al. reference also do not recognize or address the problems solved by the present invention as discussed in a summary manner at page 15, final paragraph, of the present specification.

Accordingly, as previously stated in response to the last Official Action, the Kay, et al. reference is an example of the sort of device upon which the present invention is intended to improve. As far as Kay, et al. are concerned, any polarization compensation function required by their apparatus is taken care of by a separate lens that is separately mounted in the optical pathway of the light. Kaye, et al. simply do not teach, disclose or suggest the use of any compensation films *per se*, nor do they teach, disclose or suggest that a compensation film integrated with another element of the device will accomplish the required compensation function with fewer components in a smaller unit with less required adjustment. The Kay, et al. reference consequently does not teach disclose or suggest all of the elements of the present invention as set forth in the present claims. Thus, under the above-quoted standards, the Kay, et al. reference clearly and unambiguously fails to anticipate the present invention.

The Examiner appears to be under the misapprehension that simply because the Kay reference recognizes the benefits of polarization circularization and/or diffraction compensation and discloses a transparent substrate formed integrally with other elements of the device disclosed therein, he is entitled to characterize the substrate disclosed as a "compensation film" to which he can attribute numerous attributes even though the art disclosing that substrate teaches away from that concept. Specifically, the reference teaches the use of a lens separate from the remainder of the system disclosed for polarization circularization as well as that the grating beam splitter and the transparent substrate may be combined (i.e., the grating beam splitter sandwiched between layer of the transparent substrate) which the Examiner equates to compensation of the diffracting beam. Applicants respectfully submit that such an approach to the examination of the claims of a patent application is totally inappropriate.

The simple fact is that nothing in the reference ties the recognition of the desirability of certain functional characteristics to the disclosed structure, i.e., a transparent substrate.. Consequently, the Examiner's approach only can be characterized either as total hindsight wherein isolated pieces of the prior art are assembled to recreate the claims with reference to Applicants' disclosure, or some sort of "obvious to try" reasoning totally lacking in concrete support within the four corners of the art relied upon. In either event, the Examiner's rejections are respectfully submitted to be either improper or without adequate foundation.

For each and all of the foregoing reasons, it is respectfully submitted (i) that the Examiner's analysis of the cited art is in error as he has applied it to the present claims, (ii) that upon reconsideration the Examiner will agree that his present rejections should be withdrawn for the reasons herein stated, and (iii) that the claims of this application as they will stand upon the grant of entry to the foregoing Amendment are in condition for allowance. Reconsideration of this application, the entry of the foregoing amendment, and the allowance of Claims 1-11 as hereinabove amended in response to this communication, therefore, are respectfully requested.

Finally, Applicants believe that additional fees are not required in connection with the consideration of this response to the currently outstanding Official Action. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge and/or credit Deposit Account No. **04-1105**, as necessary, for the correct payment of all fees which may be due in connection with the filing and consideration of this communication.

Respectfully submitted,

Date: November 4, 2003

By: David A. Tucker
David A. Tucker
Reg. No. 27,840
Attorney for Applicant(s)

EDWARDS & ANGELL, LLP
P.O. Box 9169
101 Federal Street
Boston, MA 02109
(617) 517-5508
353501